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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

In re Application of:

TAKAHIRO YAJIMA, ET AL.

Examiner: Anna M. Crowell

Group Art Unit: 1763

Application No.: 09/769,328

Filed: January 26, 2001

For: DEPOSITED-FILM FORMATION
APPARATUS, AND
DEPOSITED-FILM FORMATION
PROCESS

August 4, 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. § 1.181 TO
VACATE THE FINALITY OF AN OFFICE ACTION**

Sir:

Applicants respectfully request the Commissioner to vacate the finality of the Official Action (Paper No. 9) dated June 13, 2003, as being premature, and to issue a new, non-final action, resetting the period for response. The reasons warranting this relief are as follows.

FACTS

1. The Examiner issued a first action rejection (Paper No. 7), dated November 29, 2002, based on 35 U.S.C. 102(b), 35 U.S.C. 103 and 35 U.S.C. 112, second paragraph. The Examiner found claims 1-3 and 9 anticipated by Niso et al. (JPP02-217399) and claims 4-6 obvious over Niso in view of Tsubone (JPP63-69234) and Itoh

(‘741). The Examiner also found claims 1-6 and 9 indefinite under Rule 112, second paragraph.

2. Applicants filed an amendment paper dated March 31, 2003, amending the claims rejected under 112, ¶2 to clarify that the substrate acts (rather than servable) as an electrode. Applicant also argued that Niso fails as a reference under §102 and §103 because it does not teach a specific distance between the undulating substrate and the curved electrode, as required by the originally claimed invention.

3. In response to the Amendment, which argued the merits of the original claims and merely clarified certain informal language unrelated to applicant’s § 102 and § 103 argument, the Examiner introduced a new ground of rejection based on a new prior art reference (“Roth”) and made the rejection final on June 13, 2003. This was improper.

4. Under MPEP 706.07(a), “[S]econd or any subsequent actions shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by an applicant’s amendment ... nor based on information submitted in an information disclosure statement” 706.07(a) further clarifies that “[a] second or subsequent action on the merits should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.” A rejection for incompleteness typifies such a situation (where the second action should not be made final), for “one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element.”

5. The Examiner’s issue of a final rejection was improper under MPEP 706.07(a). Applicants’ amendment served to make clear that the substrate acted as an

✓ electrode, to resolve the Rule 112 objection. Applicants' argument, that the distance between the substrate and curved electrode distinguished the present claimed invention over the prior art, was unrelated to and unchanged by the claim clarifications. The new ground of rejection was not necessitated by applicant's amendment.

6. Because the applicants' amendment was made to respond to a Rule 112, second paragraph objection, it was made to "include [a] limitation which should reasonably have been expected to be claimed." Under MPEP 706.07(a), it was improper for the Examiner to make the rejection final, based on prior art not of record, of a claim amended to include such a limitation.

7. If, for any reason, the Examiner was uncertain as to the meaning of the claimed invention, the claims could have been rejected on formal grounds, and no search made until the claims were clarified. However, the Examiner was able to conduct a prior art search. Applicants submit that a key feature (specific distance) not found in the art originally cited, necessitated a second search for a new reference. The feature warranting the second search (the distance limitation) was not amended. Therefore, the second action should not have been made final because a new ground of rejection was introduced that was not necessitated by applicants' amendment.

RELIEF REQUESTED

The Commissioner is respectfully requested to vacate the finality of the outstanding office action as being premature and to issue a new, non-final action, resetting the period of response for an additional three months.

FEE

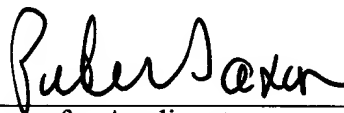
No fee is due. If it is deemed that a petition fee is due, the fee maybe charged to Deposit Account 06-1205.

CONCLUSION

Favorable consideration hereof is respectfully solicited. This paper is not a response to the merits of the outstanding action.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,



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